

Docket No. 3840-006-27

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

IN RE APPLICATION OF: Lakshman R. SEHGAL, et al.

ART UNIT: 1642

SERIAL NO: 10/785,156

EXAMINER:

FILING DATE: February 25, 2004

FOR: THERAPEUTIC APPLICATIONS OF THROMBOMODULIN GENE VIA
VIRAL AND NON-VIRAL VECTORS

PETITION PURSUANT TO 37 C.F.R. §1.47(a)

ASSISTANT COMMISSIONER FOR PATENTS
PO BOX 1450
ALEXANDRIA, VA 22313-1450

SIR:

Pursuant to the provisions of 37 C.F.R. §1.47(a), it is respectfully requested that the above-captioned application, and the Declaration in support thereof, be accepted on behalf of inventors Lakshman R. Sehgal and Jonathan Wong, whose executed Declaration is submitted herewith, and on behalf of the non-signing inventor, Prem Seth. Mr. Seth has been provided with copies of the patent application and the Declaration and has been given opportunities to execute the Declaration but has refused to do so.

Concurrently submitted herewith is the required Statement Pursuant to 37 C.F.R. §1.47 providing the statement of facts executed by David Wolf, who has first-hand knowledge of the efforts to obtain the signature of Mr. Seth.

The pertinent facts are as follows:

1. The above-referenced application was conceived of and reduced to practice by Lakshman R. Sehgal, Jonathan Wong and Prem Seth.

2. The above-referenced application for patent entitled “Therapeutic Applications of Thrombomodulin Gene Via Viral and Non-Viral Vectors” on behalf of Lakshman R. Sehgal, Jonathan Wong and Prem Seth was filed on February 25, 2004, and claimed priority to U.S. Provisional Application Serial No. 60/449,408, filed February 25, 2003, on behalf of Prem Seth.

3. At the time of filing the provisional application, Prem Seth was an employee of Evanston Northwestern Healthcare Research Institute (hereinafter “ENHR Institute”), and Prem Seth had signed an Assignment of Application which assigned his inventive rights in relation to the provisional application to Biovec, LLC (Exhibit A).

4. Prem Seth ceased work on the subject matter of their application.

5. A Declaration signed by two of the inventors, Lakshman R. Sehgal and Jonathan Wong, is submitted herewith.

6. Prem Seth, named co-inventor of the above-referenced application, was provided with a copy of the above-referenced patent application and a copy of the Declaration, and given an opportunity to sign the Declaration.

7. Prem Seth, named co-inventor of the above-referenced application, refused to sign the Declaration and the reason for such refusal was an internal dispute within Evanston Northwestern Healthcare Research Institute.

8. The concurrently submitted Statement Pursuant to 37 C.F.R. §1.47 executed by David Wolf, a director of Biovec, LLC, having first-hand knowledge of the events sworn to therein, provides a statement of facts related to the efforts of Biovec, LLC to obtain the signature of Prem Seth on the Declaration (Exhibit B).

9. Laksrnan R. Sengai and Jonathan Wong, under the provisions of 37 C.F.R. §1.47(a), are making application for a patent on behalf of themselves and Prem Seth.

10. The last known address of Prem Seth is:

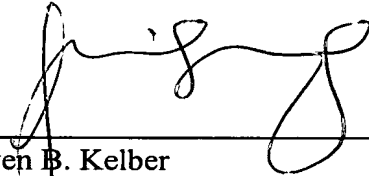
3405 Meadow Lane
Glenview, IL 60025
U.S.A

11. The required fee of \$130.00 specified in 37 C.F.R. §1.17(h) is submitted herewith by check and any further charges may be made against the Attorney of Record's Deposit Account No. 50-1442.

You are invited to contact the undersigned counsel for further information that may be required. It is understood that the non-signing inventors may subsequently join the application on filing of an appropriate Declaration.

Respectfully submitted,

PIPER RUDNICK LLP



Steven B. Kelber
Registration No. 30,073
Attorney of Record

Ping Wang
Registration No. 48,328

1200 Nineteenth Street, N.W.
Washington, D.C. 20036-2412
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Declaration, Power of Attorney and Petition

WE (I) the undersigned inventor(s), hereby declare(s) that:

My residence, post office address and citizenship are as stated below next to my name,

We (I) believe that we are (I am) the original, first, and joint (sole) inventor(s) of the subject matter which is claimed and for which a patent is sought on the invention entitled

**THERAPEUTIC APPLICATIONS OF THROMBOMODULIN GENE VIA VIRAL AND
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the specification of which

☐ is attached hereto.

☒ was filed on February 25, 2004

as Application Serial No. 10/785,156

and amended on _____

☐ was filed as PCT international application

Number _____

on _____

and was amended under PCT Article 19

on _____ (if applicable).

We (I) hereby state that we (I) have reviewed and understand the contents of the above-identified specification, including the claims, as amended by any amendment referred to above.

We (I) acknowledge the duty to disclose information known to be material to the patentability of this application as defined in Section 1.56 of Title 37 Code of Federal Regulations.

We (I) hereby claim foreign priority benefits under 35 U.S.C. § 119(a)-(d) or § 365(b) of any foreign application(s) for patent or inventor's certificate, or § 365(a) of any PCT International application which designated at least one country other than the United States, listed below and have also identified below, by checking the box, any foreign application for patent or inventor's certificate, or PCT International application having a filing date before that of the application on which priority is claimed. Prior Foreign Application(s)

Application No.	Country	Day/Month/Year	Priority Claimed	
_____	_____	_____	<input type="checkbox"/> Yes	<input type="checkbox"/> No
_____	_____	_____	<input type="checkbox"/> Yes	<input type="checkbox"/> No
_____	_____	_____	<input type="checkbox"/> Yes	<input type="checkbox"/> No
_____	_____	_____	<input type="checkbox"/> Yes	<input type="checkbox"/> No

We (I) hereby claim the benefit under Title 35, United States Code, §119(e) of any United States provisional application(s) listed below.

60/449,408	February 25, 2003
_____ (Application Number)	_____ (Filing Date)
_____ (Application Number)	_____ (Filing Date)

We (I) hereby claim the benefit under 35 U.S.C. §120 of any United States application(s), or §365(c) of any PCT International application designating the United States, listed below and, insofar as the subject matter of each of the claims of this application is not disclosed in the prior United States or PCT International application in the manner provided by the first paragraph of 35 U.S.C. §112, I acknowledge the duty to disclose information which is material to patentability as defined in 37 CFR §1.56 which became available between the filing date of the prior application and the national or PCT International filing date of this application.

Application Serial No.	Filing Date	Status (pending, patented, abandoned)
_____	_____	_____
_____	_____	_____
_____	_____	_____

And we (I) hereby appoint Steven B. Kelber, Reg. No. 30,073; Jerold I. Schneider, Reg. No. 24,765; Dale Lazar, Reg. No. 28,872; John Pike, Reg. No. 41,253; James M. Heintz, Reg. No. 41,828; Perry E. Van Over, Reg. No. 42,197; Lisa K. Norton, Reg. No. 44,977; Patrick R. Delaney, Reg. No. 45,338; Michael Ye, Reg. No. 47,195; Christopher W. Raimund, Reg. No. 47,258; Ping Wang, Reg. No. 48,328; and Susan Jensen, M.D., Reg., No. 55,775 as our (my) attorneys, with full powers of substitution and revocation, to prosecute this application and to transact all business in the Patent Office connected therewith; and we (I) hereby request that all correspondence regarding this application be sent to Supervisor, Patent Prosecution Services, Piper Rudnick LLP, 1200 Nineteenth Street, N.W., Washington, D.C. 20036-2412.

We (I) declare that all statements made herein of our (my) own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issuing thereon.

Lakshman R. SEHGAL

NAME OF FIRST INVENTOR

Residence: 4324 Hammersmith

Glenview, IL 60025

Signature of Inventor

Citizen of: United States

Post Office Address: Same As Above

Date

July 22, 2004

Jonathan WONG

NAME OF SECOND JOINT INVENTOR

Signature of Inventor

Date

Prem SETH

NAME OF THIRD JOINT INVENTOR

Signature of Inventor

Date

NAME OF FOURTH JOINT INVENTOR

Signature of Inventor

Date

NAME OF FIFTH JOINT INVENTOR

Signature of Inventor

Date

Residence: 2625 N. Clark Street, Apt. 1408
Chicago, IL 60614

Citizen of: United States

Post Office Address: Same As Above

Residence: 3405 Meadow Lane
Glenview, IL 60025

Citizen of: United States

Post Office Address: Same As Above

Residence:

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Post Office Address:

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STATEMENT OF DAVID WOLF
PURSUANT TO 37 C.F.R. §1.47

ASSISTANT COMMISSIONER FOR PATENTS
PO BOX 1450
ALEXANDRIA, VA 22313-1450

SIR:

I, David Wolf, a director of Biovec, LLC, sent an Appointment of Agent of the above-referenced patent application to Prem Seth, one of the three inventors named in the present application on June 25, 2004, c/o Evanston Northwestern Healthcare Research Institute, 2650 Ridge Avenue, Evanston, IL. 60201. I received a letter dated July 12, 2004 from the Director, Research Development of Evanston Northwestern Healthcare Research Institute stating that Dr. Seth would not be signing the Appointment of Agent. On October 21, 2004, Prem Seth orally stated to me that he would not sign the Declaration. Prem Seth stated that the reason for such refusal was an internal dispute within Evanston Northwestern Healthcare Research Institute. The two co-inventors, Lakshman R. Sehgal and Jonathan Wong, have signed the Declaration.

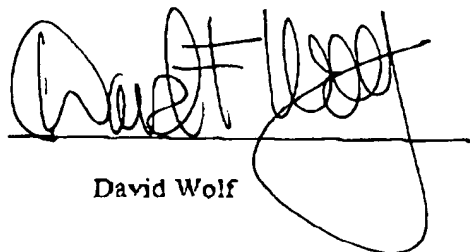
In response to the oral refusal to sign the Declaration described above, I sent an email correspondence to Prem Seth confirming his refusal to sign the Declaration, which is provided as Attachment (1).

Prem Seth persists in his refusal to join the other two named inventors in signing the Declaration.

I hereby declare that all statements made herein of my own knowledge are true, and that all statements made on information and belief are believed to be true; and further, that these statements are made with the knowledge that willful false statements, and the like so made, are punishable by fine, imprisonment, or both, 18 U.S.C. §1001, and that such willful false statements may jeopardize the validity of the above-captioned patent application or any patent to issue thereon.

November 8, 2004

Date



David Wolf